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| LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109 | | | EXAMINER NGUYEN, THU HA T | |
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DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,179

Applicant(s)

ST. PIERRE, ROBERT P.

Examiner

Thu Ha T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2000.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1- 36 are presented for examination.

Claim Objections

2. Claim 36 is objected to because of the following informalities: claim 35 claimed direct to a *method comprising the steps of*; however, claim 36 claimed direct to a medium. Hence, medium claim 26 should not depend on method claim 35.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 1, 19 and 35 recite the limitation "the display of received message". There is insufficient antecedent basis for this limitation in the claim. There is nowhere showing the step of displaying a received message in the claimed limitations.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 35 recited the limitation "A medium for use with a display device with a network interface" which does not clearly address/indicate a claimed computer readable medium encoded with a computer

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program or a computer readable medium storing program instructions. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. See MPEP § 2106 under subsection "IV. DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 101".

102(e)

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 37 1(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-6, 18-22, and 34-36 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Nawaz et al.** (hereinafter Nawaz) U.S. Patent No. **6,421,694**.

8. As to claim 1, **Nawaz** teaches the invention as claimed, including a method for displaying messages on a display device (figure 7, element 250), said messages originating from a plurality of networked electronic devices interfaced with a network (figure 7, elements 256, 258, 20, 260, 262, 264), said method comprising the steps of:

providing a protocol to enable multiple networked devices to send messages to a display device (col. 1, lines 55-60, col. 3, lines 26-46, col. 9, lines 29-48, col. 15, lines 46-56);

enabling said display device to receive said messages (abstract, col. 11, lines 39-col. 12, lines 14); and

enabling said display device to prioritize the display of received messages (col. 9, lines 49-62; col. 11, lines 30-38, col. 12, lines 15-37).

9. As to claim 2, **Nawaz** teaches the invention as claimed, wherein the network is an Internet Protocol (IP) based network (col. 1, lines 55-60).

10. As to claim 3, **Nawaz** teaches the invention as claimed, wherein said method further comprises the step of: registering a selected one of said networked electronic devices with said display device, prior to said display device displaying any messages from said selected networked electronic device (col. 10, lines 9-58). **Nawaz** teaches the clients register with servers in order to communicate with each other. This feature deems to be inherent with the system because in a client-server environment, multiple servers are connected to a client and interchangeable. The client (read as display device) registers with a server (networked electronic device) can be interchangeable for a server registers with a client, vice versa. Since both client and server have to register in order to communicate and exchange information with each other.

11. As to claim 4, **Nawaz** teaches the invention as claimed, wherein a plurality of networked electronic devices register with said display device (col. 10, lines 9-58).

12. As to claim 5, **Nawaz** teaches the invention as claimed, wherein said registering further comprises: sending to the display device a text string representing a device name for the selected networked electronic device (col. 7, lines 35-43, col. 11, lines 39-56).

13. As to claim 6, **Nawaz** teaches the invention as claimed, wherein said method further comprises the step of: sending to the display device a graphical image representing the selected networked electronic device (col. 12, lines 65-col. 13, lines 4).

14. As to claim 18, **Nawaz** teaches the invention as claimed, wherein said messages are written using the using the extensible markup language (XML) (col. 1, lines 61-col. 2, lines 36, col. 11, lines 39-col. 12, lines 14).

15. As to claim 19, **Nawaz** teaches the invention as claimed, including a method for displaying messages on a display device, said messages originating from a plurality of networked electronic devices, said networked electronic devices interfaced with a network located in a motor vehicle, said method comprising the steps of:

providing a protocol to enable multiple networked devices to send messages to a display device (col. 1, lines 55-60, col. 3, lines 26-46, col. 9, lines 29-48, col. 15, lines 46-56);

enabling said display device to receive said messages (abstract, col. 11, lines 39-col. 12, lines 14); and

enabling said display device to prioritize the display of said received messages (col. 9, lines 49-62, col. 11, lines 30-38, col. 12, lines 15-37).

16. As to claim 20, **Nawaz** teaches the invention as claimed, wherein said method further comprises the step of: registering a selected one of said networked electronic devices with said display device, prior to said display device displaying any messages from said selected networked electronic device, and sending a text string representing a device name to the display device from the selected networked electronic device as part of said registration (col. 7, lines 35-43, col. 10, lines 9-58, col. 11, lines 39-56). **Nawaz** teaches the clients register with servers in order to communicate with each other. This feature deems to be inherent with the system because in a client-server environment, multiple servers are connected to a client and interchangeable. The client (read as display device) registers with a server (networked electronic device) can be interchangeable for a server registers with a client, vice versa. Since both client and server have to register in order to communicate and exchange information with each other.

17. As to claim 35, **Nawaz** teaches the invention as claimed, including a medium for use with a display device with a network interface, said medium holding computer - executable instructions for a method, said method comprising the steps of:

providing a protocol to enable multiple networked devices to send messages to a display device (col. 1, lines 55-60, col. 3, lines 26-46, col. 9, lines 29-48, col. 15, lines 46-56), and

enabling said display device to receive said messages (abstract, col. 11, lines 39-col. 12, lines 14); and

enabling said display device to prioritize the display of received messages (col. 9, lines 49-62, col. 11, lines 30-38, col. 12, lines 15-37).

18. As to claim 36, **Nawaz** teaches the invention as claimed, wherein said network is an Internet Protocol (IP) based network (col. 1, lines 55-60).

19. Claims 21-22 and 34 have similar limitations as claims 4, 6 and 18; therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 7- 13, 16-17, 23-29, and 32-33 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Nawaz**, in view of **Hebel et al.** (hereinafter Hebel) U.S. Patent No. **6,073,177**.

22. As to claim 7, **Nawaz** teaches the invention as claimed, said method comprising the additional steps of:

receiving a display message at the display device from a given one of the networked electronic devices (abstract, col. 11, lines 39-col. 12, lines 14); and

placing the received display message in the priority message queue for the given networked electronic device (col. 9, lines 49-62, col. 11, lines 30-38, col. 12, lines 15-37).

However, **Nawaz** does not explicitly teach creating a separate priority message queue on the display device for each networked electronic device that is registered with the display device; and assigning a priority level to each priority message queue. **Hebel** teaches creating a separate priority message queue on the display device for each networked electronic device that is registered with the display device (figure 2, element 13, figure 4A, col. 5, lines 34-61, col. 15, lines 55-58, lines 62-63); and assigning a priority level to each priority message queue (col. 5, lines 622-col. 6, lines 7). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Nawaz and Hebel** to include the step of creating a separate priority message queue for each network electronic device and assigning priority level to each priority message queue because it would have an efficient communications system that can monitor and manage which message is more important or urgent in order to process first.

23. As to claim 8, **Nawaz** teaches the invention as claimed, wherein said received display message in the message queue for the given networked electronic device contains text (col. 1, lines 45-54, col. 7, lines 35-43, col. 11, lines 39-56).

24. As to claim 9, **Nawaz** teaches the invention as claimed, wherein said received display message in the message queue for the given networked electronic device contains a graphical image (col. 12, lines 65-col. 13, lines 4).

25. As to claim 10, **Nawaz** teaches the invention as claimed, wherein said received display message in the message queue for the given networked electronic device contains both text and a graphical image (col. 1, lines 45-54, col. 7, lines 35-43, col. 11, lines 39-56, col. 12, lines 65-col. 13, lines 4).

26. As to claim 11, **Nawaz** teaches the invention as claimed, said method comprising the additional steps of providing a priority level for each display message sent from the given networked electronic device to the display device (col. 11, lines 30-col. 12, lines 37). However, **Nawaz** does not explicitly teach creating a unique message ID identifying each message placed in said priority message queue of said given networked electronic device. **Hebel** teaches creating a unique message ID identifying each message placed in said priority message queue of said given networked electronic device (col. 6, lines 9-24, col. 9, lines 20-25). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to

combine the teachings of **Nawaz and Hebel** to include the step of creating a unique message ID identifying each message because it would provide an efficient communications system that can keep track, monitor and prioritize message based on message unique identifier.

27. As to claim 12, **Nawaz** teaches the invention as claimed, said method comprising the additional steps of: selecting a highest priority message queue, said priority message queue containing at least one message; selecting from within said highest priority message queue a message with the highest message priority level; and displaying said selected message on said display device (col. 11, lines 30-col. 12, lines 37). However, **Nawaz** does not explicitly teach selecting a highest priority message queue *among the priority message queues*. **Hebel** teaches selecting a highest priority message queue *among the priority message queues* (col. 5, lines 39-col. 6, lines 7). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Nawaz and Hebel** to include the step of selecting a highest priority message queue among the priority message queues because it would have an efficient communications system that can monitor and manage which message is more important or urgent in order to process first.

28. As to claim 13, **Nawaz** does not explicitly teach the invention as claimed; however, **Hebel** teaches sending a request to said display device from a registered networked electronic device that is registered with the display device to remove a

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message from the priority message queue of said registered networked electronic device (col. 8, lines 36-64). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Nawaz and Hebel** to include the step of ending a request to said display device from a registered networked electronic device to remove a message from the priority message queue of said registered networked electronic device because it would have an efficient communications system to monitor and manage the change of message queues.

29. As to claim 16, **Nawaz** teaches the invention as claimed, said method comprising the additional step of: including display instructions as part of the display message sent to said display device by the given networked electronic device registered with said display device (col. 9, lines 29-62, col. 11, lines 39-col. 12, lines 14).

30. As to claim 17, **Nawaz** teaches the invention as claimed, said method comprising the additional step of: unregistering said given networked electronic device registered with said display device (col. 10, lines 9, lines 18).

31. Claims 23-29 and 32-33 have similar limitations as claims 7-13 and 16-17; therefore, they are rejected under the same rationale.

32. Claims 14-15 and 30-31 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Nawaz and Hebel**, further in view of **Menig et al.** (hereinafter Menig) U.S. Patent No. **6,289,332**.

33. As to claim 14, **Nawaz and Hebel** do not explicitly teach the invention as claimed; however, **Menig** teaches sending a list of Message IDs appearing in a priority message queue from said display device to a particular networked electronic device registered with said display device in response to a request from said particular networked electronic device (col. 17, lines 23-36, col. 18, lines 27-38). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Nawaz, Hebel and Menig** because it would have an efficient communications system that provide operating, diagnostic and warning information of the networked devices to display device in order to resolve the problem based on the priority of each message.

34. As to claim 15, **Nawaz and Hebel** do not explicitly teach the invention as claimed; however, **Menig** teaches sending a status message providing a current status of a message in a priority message queue from said display device to a registered networked electronic device registered with said display device in response to a request from said registered networked electronic device (col. 18, lines 26-38, col. 22, lines 1-col. 23, lines 6). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of

Nawaz, Hebel and Menig because it would have an efficient communications system that can keep track and detect the status of networked devices in order to resolve the problem based on the priority of each message.

35. Claims 30-31 have similar limitations as claims 14-15; therefore, they are rejected under the same rationale.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

37. Narasimhan et al. (USPN 6,597,688), Bourgeois et al. (USPN 6,108,534), Berkowitz et al. (USPN 5,392,400), Donaldson (USPN 6,321,267), Dyer et al. (USPN 6,442,596), Capps et al. (USPN 6,563,836), Kroon (USPN 6,816,458), Schiavone et al. (US-Pub No. 2002/0120702) are recited for disclosing various information related to the claimed invention. Applicants are requested to consider these prior art references when responding to this office action.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (571) 272-3989. The examiner can normally be reached Monday through Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached at (571) 272-3978.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications.

Thu Ha Nguyen

November 22, 2004


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER